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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/731,294
Filing Date: December 09, 2003
Appellant(s): TIDWELL ET AL.

Charles Gray
For Appellant

EXAMINER'S ANSWER

This is an Examiner's Answer in response to the Board of Patent Appeals remand dated 6/9/2010 and the applicant's appeal brief filed May 13, 2009 appealing from the Office action mailed August 18, 2008.

(1) Real Party in Interest

The examiner has no comment on the appellant's statement identifying by name the real party in interest contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-24

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim limitations “means for obtaining at a point-of-sale device location-related data...and means for receiving at the point-of-sale device a recommendation..” uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because a claim limitation does not invoke 35 U.S.C. 112, sixth paragraph, if the phrase “means for” or “step for” is modified by sufficient structure, material, or acts recited in the claim for performing the claimed function. Here, the phrase “means for” is modified by the point of sale device.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

7,257,246	Brodie et al	08-2007
6,105,011	Morrison, Jr.	8-2000

"Official Notice" as evidenced by Morrison, Jr

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodie et al (US Patent No. 7,257,246) in view of "Official Notice" as evidenced by Morrison, Jr. (US 6,105,011).

3. As per claim 1, Brodie et al teach a point-of-sale device comprising:

a display; a keypad; a communications interface and a computer processor in communication with the display, the keypad and the communications interface (**column 3, lines**

35-47) the computer processor configured to request *check data* presented in association with a check-cashing transaction the computer processor further configured to obtain *the check data* from the keypad the *check data* (**column 2, lines 8-20**) and to transmit *the check data* to a remote location via the communications interface the computer processor further configured to receive via the communications interface from a check authorization system an indication of a level of risk associated with cashing the check (**column 6, lines 35-64, column 2, lines 23-60**), the computer processor further configured to display on the display a message based at least in part on the indication (**column 13, line 60-column 14, line 15**).

Although Brodie et al teach determining the check type (**column 10, line 57**) which is evidence that multiple check types can be cashed in Brodie et al's system, they fail to teach that the check is a *payroll check* and that the *location information about an employer who has issued a payroll check is obtained and used for risk assessment*. However, "Official Notice" is taken that the concept and advantage of this feature are well known in the art as evidenced by Morrison, Jr who teaches a secure system for business interactions with customers that includes obtaining check data including the identity of the employer (**see at least column 7, lines 16-34**). It would have been obvious to one of ordinary skill in the art to modify Brodie et al's system to include this feature because doing so would allow for Brodie et al's system to cash payroll checks by verifying that the issuer of the check (employer) is a local company.

4. As per claim 2, Brodie et al teach wherein the display is further configured to display a prompt to an operator of the point-of-sale device requesting the *check data* (**column 2, lines 8-15, column 4, lines 29-44, column 6, lines 15-23**).

5. As per claim 3, Brodie et al teach wherein the display is configured to display the prompt in response to a message received from the check authorization system via the communications interface **(column 13, line 60-column 14, line 15)**.

6. As per claim 4, Brodie et al teach a point-of-sale device comprising:
a communications interface; an input system and a computer processor in communication with the communications interface and the input system **(column 3, lines 35-47)**, the computer processor configured to obtain from the input system *check data* associated with a check presented for processing **(column 2, lines 8-20)** and to transmit to a remote location via the communications interface information about the *check data*, the computer processor further configured to receive via the communications interface from a check authorization system an indication of a level of risk associated with processing the check **(column 6, lines 35-64, column 2, lines 23-60)**.

Brodie et al fail to teach that *location related data about a check issuer is obtained and used for risk assessment*. However, it would have been obvious to one of ordinary skill in the art to modify Brodie et al's system to include this feature because doing so would allow for Brodie et al's system to authenticate the check by verifying that the check issuer is a local company.

7. As per claim 5, Brodie et al teach wherein the input system comprises at least one of: a keypad, a voice recognition system, a touchscreen, an optical character reader, a scanner, a smartcard reader, and a stylus **(column 3, lines 45-47)**.

8. As per claim 6, Brodie et al fail to teach wherein the information about the check issuer is *a company name associated with the check issuer*. However, it would have been obvious to one of ordinary skill in the art to modify Brodie et al's system to include this feature because

doing so would allow for Brodie et al's system to authenticate the check by verifying that the check issuer is a local company.

9. As per claim 7, Brodie et al fail to teach wherein the information about the check issuer that the computer processor is configured to transmit comprises information about a company location associated with the check issuer. However, it would have been obvious to one of ordinary skill in the art to modify Brodie et al's system to include this feature because doing so would allow for Brodie et al's system to authenticate the check by verifying that the check issuer is a local company.

10. As per claim 8, Brodie et al teach further comprising a display, wherein the computer processor is in communication with the display and is configured to display on the display a message based at least in part on the indication **(column 13, line 60-column 14, line 15)**.

11. As per claim 9, Brodie et al teach wherein processing the check comprises cashing the check **(abstract; check cashing)**.

12. As per claim 11, Brodie et al teach wherein obtaining location-related data about the check issuer comprises reading a magnetic ink character recognition (MICR) line from the check **(column 6, lines 30-34)**.

13. As per claim 12, Brodie et al teach wherein obtaining location-related data about the check issuer comprises scanning an image of at least a portion of a check associated with the check transaction **(column 6, lines 18-30)**.

14. As per claim 13, Brodie et al teach using optical character recognition (OCR) technology to obtain information about the check issuer from the scanned image (**column 6, lines 18-30**).

15. As per claim 14, Brodie et al teach wherein obtaining location-related data about the check issuer comprises requesting the location-related data from a presenter of a check associated with the check transaction (**column 2, lines 8–15**).

16. As per claim 16, Brodie et al teach wherein the financial transaction comprises cashing a negotiable instrument (**column 1, lines 20-30**).

17. As per claim 17, Brodie et al teach wherein the negotiable instrument is a money order, a traveler's check, a personal check, a corporate check, company insurance refund check, a government check, such as a tax refund check, Social Security check, payroll check, or other government-issued check, a bank check, official check, or a convenience check (**column 1, lines 20-40**).

18. As per claim 18, Brodie et al teach a display, wherein the computer processor is in communication with the display and wherein the computer processor is further configured to display on the display a message based at least in part on the indication (**column 13, line 60-column 14, line 15**).

19. As per claim 10, 15, and 19-24, these claims contain similar limitations as the claims above, therefore are rejected under the same rationale.

NEW GROUNDS OF REJECTION:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

(10) Response to Argument

Argument: *The Appellant has traversed the Examiner's Official Notice and has requested evidence. Brodie does not describe all of the limitations of the claims; more specifically, “request location information about an employer who has issued a payroll check” and “obtain from the keypad the employer location information and to transmit the employer location information to a remote location”.*

In response, the Examiner asserts that the 103 rejection in view of Brodie meets the claimed limitations. Brodie et al teach the computer processor configured to request *check data* presented in association with a check-cashing transaction the computer processor further configured to obtain *the check data* from the keypad the *check data* (**column 2, lines 8-20**) and to transmit *the check data* to a remote location via the communications interface (**column 6, lines 35-64, column 2, lines 23-60**). Although Brodie et al teach determining the check type (**column 10, line 57**) which is evidence that multiple check types can be cashed in Brodie et al's system, Brodie fails to explicitly teach that the check is a *payroll* check and that the check data is *location information about an employer who has issued a payroll check*. However, the use of payroll checks is notoriously well known in the art as well as the cashing of payroll checks. It is further well known that issuer information such as address information is printed on checks. “Official Notice” is taken that the concept and advantage of these features are well known in the art as evidenced by Morrison, Jr who teaches a secure system for business interactions with customers that includes obtaining check data including the identity of the employer (**see at least**

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column 7, lines 16-34). It would have been obvious to one of ordinary skill in the art to modify Brodie et al's system to include this feature because doing so would allow for Brodie et al's system to cash payroll checks by verifying that the issuer of the check (employer) is a local company.

Additionally, it is noted that **KSR** forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under **KSR**, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than **predictable results** to one of ordinary skill in the art at the time of the invention. Furthermore, under **KSR**, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Ramsey Refai/

Primary Examiner, Art Unit 3627

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

*

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Vincent Millin /vm/
Appeals Practice Specialist

*